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Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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REISSUE APPLICATION DECLARATION BY THE ASSIGNEE

Docket Number (optional)

CPI 40076D

I hereby declare that:

The residence, mailing address and citizenship of the inventors are stated below.

I am authorized to act on behalf of the following assignee: Stora Enso North America Corp.and the title of my position with said assignee is: Senior Vice PresidentThe entire title to the patent identified below is vested in said assignee. Reel 8996, Frame 0644
Reel 11770, Frame 0738Inventor Charles A. NormingtonCitizenship USAResidence/Mailing Address 210 9th. Street S, Wisconsin Rapids, WI 54494Inventor Gregory E. PulchinskiCitizenship USAResidence/Mailing Address 3421 36th. Street S, Wisconsin Rapids, WI 54494☒ Additional Inventors are named on separately numbered sheets attached hereto.Patent Number 5,952,082Date of Patent Issued September 14, 1999Title of Invention Electrophotographic Recording Medium and Method

I believe said inventor(s) to be the original and first inventor(s) of the subject matter which is described and claimed in said patent, for which a reissue patent is sought on the invention entitled:

Electrophotographic Recording Medium and Method

the specification of which

☒ is attached hereto.☐ was filed on _____ as reissue application number _____ / _____and was amended on _____
(If applicable)

I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.

☐ I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or (f), or 365(b). Attached is form PTO/SB/02B (or equivalent) listing the foreign applications.

I verily believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below. (Check all boxes that apply.)

☐ by reason of a defective specification or drawing.☒ by reason of the patentee claiming more or less than he had the right to claim in the patent.☐ by reason of other errors.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.175. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2

REISSUE APPLICATION DECLARATION BY THE ASSIGNEE	Docket Number (Optional) CPI 40076D										
<p>At least one error upon which reissue is based is described as follows:</p> <p style="margin-left: 40px;">Claim 1 is invalid for failure to include in the claim the limitation that the coated paper has a particular coating weight/fiber weight ratio.</p> <p style="text-align: center;">[Attach additional sheets, if needed.]</p> <p>All errors corrected in this reissue application arose without any deceptive intention on the part of the applicant.</p> <p>I hereby appoint:</p> <div style="display: flex; align-items: center; margin-top: 10px;"> <input type="checkbox"/> Practitioners at Customer Number: </div> <p style="margin-left: 40px;">OR</p> <div style="display: flex; align-items: center; margin-top: 10px;"> <input checked="" type="checkbox"/> Practitioner(s) named below: </div> <table border="1" style="width: 100%; border-collapse: collapse; margin-top: 10px;"> <thead> <tr> <th style="width: 50%;">Name</th> <th style="width: 50%;">Registration Number</th> </tr> </thead> <tbody> <tr> <td>Michael Piontek</td> <td>25,605</td> </tr> <tr> <td>Russell W. Pyle</td> <td>23,076</td> </tr> <tr> <td>Robert A. Lloyd</td> <td>25,694</td> </tr> <tr> <td> </td> <td> </td> </tr> </tbody> </table> <p>as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith.</p>		Name	Registration Number	Michael Piontek	25,605	Russell W. Pyle	23,076	Robert A. Lloyd	25,694		
Name	Registration Number										
Michael Piontek	25,605										
Russell W. Pyle	23,076										
Robert A. Lloyd	25,694										
<p>Correspondence Address: Direct all communications about the application to:</p> <div style="display: flex; align-items: center; margin-top: 10px;"> <input type="checkbox"/> Customer Number: </div> <p style="margin-left: 40px;">OR</p> <div style="display: flex; margin-top: 10px;"> <div style="width: 20%; border: 1px solid black; padding: 2px;"> <input checked="" type="checkbox"/> Firm or Individual Name </div> <div style="width: 80%; border: 1px solid black; padding: 2px;">Robert A. Lloyd</div> </div> <div style="display: flex; margin-top: 5px;"> <div style="width: 20%; border: 1px solid black; padding: 2px;">Address</div> <div style="width: 80%; border: 1px solid black; padding: 2px;">Pyle & Piontek</div> </div> <div style="display: flex; margin-top: 5px;"> <div style="width: 20%; border: 1px solid black; padding: 2px;">Address</div> <div style="width: 80%; border: 1px solid black; padding: 2px;">221 N. LaSalle Street -- Suite 850</div> </div> <div style="display: flex; margin-top: 5px;"> <div style="width: 20%; border: 1px solid black; padding: 2px;">City</div> <div style="width: 25%; border: 1px solid black; padding: 2px;">Chicago</div> <div style="width: 5%; border: 1px solid black; padding: 2px;">State</div> <div style="width: 20%; border: 1px solid black; padding: 2px;">IL</div> <div style="width: 5%; border: 1px solid black; padding: 2px;">Zip</div> <div style="width: 25%; border: 1px solid black; padding: 2px;">60601</div> </div> <div style="display: flex; margin-top: 5px;"> <div style="width: 20%; border: 1px solid black; padding: 2px;">Country</div> <div style="width: 80%; border: 1px solid black; padding: 2px;">USA</div> </div> <div style="display: flex; margin-top: 5px;"> <div style="width: 20%; border: 1px solid black; padding: 2px;">Telephone</div> <div style="width: 30%; border: 1px solid black; padding: 2px;">(312) 236-8123</div> <div style="width: 5%; border: 1px solid black; padding: 2px;">Fax</div> <div style="width: 45%; border: 1px solid black; padding: 2px;">(312) 236-5574</div> </div>											
<p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed.</p> <p>Full name of person signing (given name, family name) Carl H. Wartman</p> <div style="display: flex; margin-top: 10px;"> <div style="width: 60%; border: 1px solid black; padding: 2px;">Signature <i>Carl H. Wartman</i></div> <div style="width: 40%; border: 1px solid black; padding: 2px;">Date <i>FEB 23 2004</i></div> </div> <div style="display: flex; margin-top: 5px;"> <div style="width: 20%; border: 1px solid black; padding: 2px;">Address of Assignee</div> <div style="width: 80%; border: 1px solid black; padding: 2px;">231 First Avenue North, Wisconsin Rapids, WI 54495</div> </div>											

Attachment to Reissue Application Declaration by the Assignee

ADDITIONAL INVENTOR

Inventor: Gary G. Schiller

Citizenship: USA

Residence/Mailing Address: 3201 61st Street N, Wisconsin Rapids, WI 54494

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re. Reissue Application of)	
Stora Enso North America)	
)	Examiner:
Serial No.:)	
)	Art Unit:
Filed:)	
)	Atty. Docket: CPI 40076D
For: Electrophotographic Recording)	
Medium and Method)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION OF GARY G. SCHILLER

I, Gary G. Schiller, declare and state as follows:

1. I am a named inventor in Patent No. 5,952,082, issued September 14, 1999 from an application filed July 18, 1997 and for which reissue is sought.

2. In the prosecution of patent 5,952,082, the Patent and Trademark Office required restriction between process and product claims. The process claims were elected for prosecution and subsequently, on June 9, 2000, a divisional and continuation-in-part application was filed with the non-elected product claims. The divisional and continuation-in-part application issued October 7, 2003 as Patent No. 6,630,229, claiming priority from patent 5,952,082.

3. I am also the named inventor in Patent No. 4,308,320, issued December 29, 1981 from an application filed August 20, 1980.

4. The invention described and claimed in patent 4,038,320 is for a method of coating and drying a paper web, wherein the paper is coated with a thermoplastic polymer having a specified minimum film forming temperature (MFFT) and is then subjected to a multiple stage drying sequence prior to calendering. The multiple stage drying sequence is performed such that the web is initially heated and dried at a web temperature above the MFFT, but no more than about 20° F above the MFFT, until the moisture content of the web is reduced to about 8%-18% by weight, whereupon heating and drying continues, but at a temperature higher than the initial drying temperature and until a final desired degree of dryness is attained. The dried and coated web is then calendered to produce a coated paper having a high bulk, excellent gloss and low surface mottle.

5. The invention described and claimed in patent 5,952,082 is for a process of making a coated paper that is adapted to provide improved fusion of toner on a surface thereof at marginal fusion temperatures in an electrophotographic process. A characteristic of the coated paper is that it has proportionally less coating and proportionally more fiber than does conventional coated paper for a given basis weight of the paper. For example, for a basis weight of at least 60 pounds per ream, coating on each side of the paper web has a weight on the order of 2.5-5.5 pounds of coating per side per ream and the coated paper has a coating weight/fiber weight ratio on the order of 6%-32%.

6. The invention of patent 5,952,082 is different from that of patent 4,308,320. Also, a characteristic of the coated paper of patent 5,952,082 is that it has proportionally less coating and proportionally more fiber than does conventional coated paper for a

given basis weight of the paper, and for a basis weight of at least 60 pounds per ream the paper has a coating weight/fiber weight ratio on the order of 6%-32%. The paper of patent 4,308,320, on the other hand, is not taught to have any particular amount of fiber for a given basis weight or coat weight, nor is any particular amount of fiber of concern in producing the paper of patent 4,308,320. To someone skilled in the papermaking art, as I am, the papers of patents 4,308,320 and 5,952,082 are so different that the teachings of patent 4,308,320 would not be considered for their materiality to the invention of patent 5,952,082.

7. In the declaration I signed in connection with the filing of patent 5,952,082, I acknowledged my duty to disclose to the Patent and Trademark Office information which is material to patentability. At the time of signing the declaration I did not consider my earlier patent 4,308,320 as being material to the patentability of the invention of patent 5,952,082, because the respective inventions are so different. I therefore did not disclose patent 4,308,320 to the Patent and Trademark Office, because to identify it as material to the invention of patent 5,952,082 would have been wrong. If I am mistaken in my belief that the teachings of patent 4,308,320 are not material to the invention of patent 5,952,082, and I do not believe that I am mistaken, then my not identifying it as being material to the patentability of the invention of patent 5,952,082 occurred through error, without any deceptive intent and without any involvement of fraud, bad faith or intentional misconduct.

8. Because of the lack of materiality of the teachings of patent 4,308,320 to the invention of patent 5,952,082, I was very surprised when it was cited and applied by the Patent and Trademark Office in a rejection of claims during the prosecution of later

filed divisional and continuation-in-part patent 6,630,229, which citation occurred well after patent 5,952,082 had issued.

9. I was justified in being surprised about the citation of my earlier patent 4,308,320 in the prosecution of patent 6,630,229. Prior to the citation of my patent 4,308,320, the patents to Windhager 4,306,996, Ma et al. 5,635,279 and Shaw et al. 4,341,839 had earlier been cited in rejections of the claims. From what was said by the examiner in the Office Action in which my patent 4,308,320 was cited, I finally understood that the examiner had all along been misconstruing the teachings of all of the references, because he erroneously believed that the basis weights of the papers taught by the references were the same as, and therefore were teachings of, fiber weights of the papers. When it was explained to the examiner that basis weight and fiber weight of a coated paper are not and cannot be the same, all of the claims were allowed in patent 6,630,229. If the examiner had not misunderstood the significance of paper basis weight versus paper fiber weight, my patent 4,308,320 would never have been cited, because it simply was not material to the claims of divisional and continuation-in-part patent 6,630,229.

10. I am submitting this declaration not because I believe I should have brought my patent 4,308,320 to the attention of the Patent and Trademark Office in connection with my patent 5,952,082 and erroneously did not, but instead to clearly set forth the reason why I did not.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent reissued thereon.



Gary G. Schiller

Date: 16 Mar 04

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STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: Stora Enso North America Corp.

Application No./Patent No.: 5,952,082 Filed/Issue Date: September 14, 1999

Entitled: Electrophotographic Recording Medium and Method

Stora Enso North America Corp. Corporation

(Name of Assignee)

(Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest; or

2. ☐ an assignee of less than the entire right, title and interest.

The extent (by percentage) of its ownership interest is _____ %
in the patent application/patent identified above by virtue of either:

A. ☒ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel 8996, Frame 0644, or for which a copy thereof is attached. and Reel 11770, Frame 0738

OR

B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

1. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

2. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

3. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

☐ Copies of assignments or other documents in the chain of title are attached.
[NOTE: A separate copy (i.e., the original assignment document or a true copy of the original document) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

FEB 23 2004

Date

(715) 422-3578

Telephone number

Carl H. Wartman

Typed or printed name

Carl H. Wartman

Signature

Senior Vice President

Title

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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